



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,986	12/05/2003	Paul Gilson	A9020	7246
80/928 7590 12/19/2008 Sughrue Mion-ABBOTT LABS 2100 Pennsylvania Avenue, N.W. Washington, DC 20037				
EXAMINER				
GRAY, PHILLIP A				
ART UNIT		PAPER NUMBER		
3767				
MAIL DATE		DELIVERY MODE		
12/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/727,986

**Applicant(s)**

GILSON ET AL.

**Examiner**

Phillip Gray

**Art Unit**

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## DETAILED ACTION

This office action is in response Applicant's communication of 11/21/2008 .  
Currently amended claims 29-42 are pending and rejected below.

### ***Response to Arguments***

Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive.

Applicant argues that the claim limitations of the "deployer" movable "in a proximal to distal direction through the pod", is not disclosed in the prior art of record, namely Dwyer.

Claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969).

Under these guidelines, it is examiners position that the Dwyer does disclose this claim limitation. Concerning the "deployer" movable "in a proximal to distal direction through the pod", examiner draws applicant's attention to figures 10a, 10b, and 10c and note the deployer moves and is movable in a proximal to distal direction through the pod (note deployer (unnumbered but attached to element 16 moves in a distal direction through the pod near element 22). Applicant's argue that the Device of Dwyer operates such that the sheath is movable relative to the positioning tube. It is examiners position that the deployer is movable in a proximal to distal direction through the pod (see

rejection below). It is recommended that applicant specify in greater detail how there movement is different then Dwyers movement.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 29-30, 32-33, 35-38 rejected under 35 U.S.C. 102(e) as being anticipated by Dwyer et al. (U.S. Patent Number 6,395,017). Dwyer discloses a catheter device (Figure 3-5) for the deployment of a medical device, with an polymeric elongate tubular body (elements 34 to elements 32 of figure 3 specifically 22 and 18), with an embracing pod (23) located at the distal end (30 as one example) of the catheter tubular body for reception of the medical device and with sufficient axial rigidity, a deployer (28 or 4)

Art Unit: 3767

movable through the pod. Further Dwyer comprises a funnel shaped bored loading device (figure 6 element 44), with a thin walled loading tube (4) projecting from a main support (44). It is examiners position that the thin walled distal portion of the catheter tubular body is of reduced wall thickness relative to a proximal portion of the catheter tubular body (elements from 20 thick section to thin or reduced section 22) and the pod has a greater flexibility then the proximal portion of the tubular body (20). All the elements of Dwyer are fully capable of satisfying all structural, spatial, functional, and operational limitations of the claims as written. Concerning the claim language of the "deployer" movable "in a proximal to distal direction through the pod", examiner draws applicant's attention to figures 10a, 10b, and 10c and note the deployer moves and is movable in a proximal to distal direction through the pod (note deployer (unnumbered but attached to element 16 moves in a distal direction through the pod near element 22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 31, 34, 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer.

In regards to claim 31, Dwyer discloses the claimed invention except for the tubular body tapers distally at a location proximal and adjacent the pod. It would have been an obvious matter of design choice to for the tubular body tapers distally at a location proximal and adjacent the pod, since it is well known in the catheter arts for wall thickness and structure to taper to enhance flexibility, support, and define a lumen.

In regards to claim 34, Dwyer discloses the claimed invention except for a wall thickness of less than or equal to 0.004 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall thickness of less than or equal to 0.004 inches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In regards to claims 39-40, Dwyer discloses the claimed invention except is silent as to the cone angles of the bore between 15 and 65 degrees or 35 and 45 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to construct a cone with angles of the bore between 15 and 65 degrees or 35 and 45 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

In regards to claim 41-42, Dwyer discloses the claimed invention except is silent as to the main support being made from Perspex or a metal spigot, and the loading tube from polytetrafluoroethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the main support from Perspex or a metal spigot, and the loading tube made from polytetrafluoroethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571)272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phillip Gray/

Examiner, Art Unit 3767

/Kevin C. Simmons/

Supervisory Patent Examiner, Art Unit 3767